

### **REMARKS**

Claims 1-12 are pending, with claims 9-12 withdrawn from consideration. Claims 1, 6 and 7 are amended. Claims 1, 6 and 7 are amended to address a rejection under 35 USC 112.

No new matter is added to the application by this Amendment. The new features added to claim 1 find support within the present specification, as originally filed, at, for example, the abstract and paragraphs [0021], [0027] and [0028] of US Patent Publication No. 2007/0237936 for the present application.

Reconsideration of the application is respectfully requested.

#### **I. Restriction Requirement**

Applicant affirms their provisional election with traverse to prosecute Group I, claims 1-8.

It is respectfully submitted that the subject matter of all claims 1-12 are sufficiently related that a thorough search for the subject matter of any one Group of claims would encompass a search for the subject matter of the remaining claims and species. Thus, it is respectfully submitted that the search and examination of the entire application could be made without serious burden. See MPEP §803 in which it is stated that "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions" (emphasis added). It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office.

Moreover, Applicants submit that claims 9 and 10, directed to a method of using a tape, and claims 11 and 12, directed to an elongate product should be rejoined with the application upon allowance of claims 1-8.

Thus, withdrawal of the Restriction Requirement is respectfully requested.

## **II. Rejection Under 35 USC 112**

Claims 1-8 were rejected under 35 USC 112, second paragraph, as allegedly being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. This rejection is respectfully traversed.

Claims 1, 6 and 7 are amended to overcome this rejection. Specifically, claim 1 is amended to remove the terms “highly” and “firmly” from the claim. Additionally, claims 6 and 7 were amended to depend from claim 2. Applicants submit that claims 1-8 are (i) definite and (ii) particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Thus, Applicants respectfully request withdrawal of the rejection under 35 USC 112, second paragraph.

## **III. Rejections Under 35 USC 102**

### **A. Boettcher**

Claims 1, 4 and 6 were rejected under 35 USC 102(b) as allegedly being anticipated by DE 10107569 (hereinafter “DE 569”). This rejection is respectfully traversed.

The Patent Office alleges that DE 569 discloses each and every feature of claims 1, 4 and 6. Applicants respectfully disagree with the allegations with respect to this rejection made by the Patent Office.

The presently claimed abrasion-resistant and noise-suppressing tape exhibits superior, unexpected and surprising abrasion resistance and noise suppression properties when compared to other two layer tapes as evidenced in TABLES 1-3 and EXAMPLES 1-3 of the present application. As shown in the tables and examples of the present application, not every tape having a combination of the two layers, such as tapes outside the scope of the present claims, exhibits the same superior abrasion resistance and noise suppression properties when compared to tapes in accordance with claim 1.

For example, if nonwoven fabrics are used for the presently claimed layer A, the resulting tape fails with respect to abrasion resistance. Nonwoven fabrics are made out of fibers. However, velours, scrims, woven fabrics and formed-loop knits are made out of yarns and have a substantially higher mechanical rigidity than nonwoven fabrics made of fibers. Thus, the abrasion resistance properties of a layer A composed of velours, scrims, woven fabrics or formed-loop knits is substantially greater than the abrasion resistance properties of nonwoven fabrics made of fibers.

DE 569 discloses a tape having a combination of a nonwoven fabric fiber layer (alleged first outer layer A) together with a needled nonwoven fabric (alleged second layer C). As discussed above, DE 569's tape fails with respect to abrasion resistance because DE 569's alleged layer A is made of a nonwoven fabric.

DE 569 fails to disclose the presently claimed layer A being composed of a velour, scrim, woven fabric or formed-loop knit. Thus, DE 569 fails to disclose the specifically defined features of amended claim 1.

Moreover, even if the Patent Office alleges that DE 569's needled nonwoven fabric layer would have been equivalent to the presently claimed our layer A and DE 569's special nonwoven fabric were to have been equivalent to presently claimed layer C, the resulting combination of DE 569's allegedly equivalent layers A and C would fail to achieve the presently claimed tape. Specifically, the resulting combination would fail to achieve the presently claimed tape because DE 569's needled nonwoven fabric is not a velour, scrim, woven fabric or formed-loop knit and such a resulting tape, in accordance with DE 569, with a needled nonwoven fabric layer would fail with respect to abrasion resistance.

Surprisingly and unexpectedly, the presently claimed tape having the combination of layer A (being comprised of velour, scrim, woven fabric or formed-loop knit) with layer C (being comprised of a textile having an open but stable three-dimensional structure) exhibits superior abrasion resistance properties and noise suppression properties when compared to tape outside the scope of the presently claimed invention.

With respect to the presently claimed invention, if outside/exterior pressure is applied onto layer A, layer C (the textile layer) allows microscopic and macroscopic movements in layer C such that layer A avoids the mechanical friction applied to layer A from the outside/exterior pressure. Thus, the destructive energy of the outside/exterior pressure does not effect layer A locally, but, instead, the destructive energy is dissipated in this surprising and unexpected manner via the microscopic and macroscopic movements in layer C (see paragraph [0027] of the present application).

Thus, DE 569 does not disclose a tape having a backing with a first outer layer A, which is connected to a second layer C over the entire area of outer layer A,

the outer layer A being composed of a velour, scrim, woven fabric or formed-loop knit, and the layer C being composed of a textile having an open but stable three-dimensional structure as required by amended claim 1.

Because these features of independent claim 1 are neither taught nor suggested by DE 569, DE 569 cannot anticipate, and would not have rendered obvious, the features specifically defined in claim 1 and its dependent claims.

For at least these reasons, claims 1, 4 and 6 are patentably distinct from and/or non-obvious in view of DE 569. Reconsideration and withdrawal of the rejection of the claims under 35 USC 102(b) are respectfully requested.

**B. DeCoste, Jr. et al.**

Claims 1, 3, 5, 6 and 8 were rejected under 35 USC 102(b) as allegedly being anticipated by US Patent No. 4,705,715 to DeCoste, Jr. et al. (hereinafter "DeCoste"). This rejection is respectfully traversed.

The Patent Office alleges that DeCoste discloses each and every feature of claims 1, 3, 5, 6 and 8. Applicant respectfully disagrees with these allegations.

DeCoste fails to disclose a two layer tape having a layer A (being composed of velour, scrim, woven fabric or formed-loop knit) and a layer C (being composed of a textile having an open but stable three-dimensional structure). Instead, DeCoste discloses a layer of foam and a thin outer skin applied to a scrim or cloth web. Moreover, DeCoste teaches that the foam melt permeates the interstices of the cloth whereby the cloth fibers may be said to be embedded in the foam layer. Thus, at best, DeCoste discloses a single layer made out of cloth whereby foam is integrated into the interstices of the cloth (see FIG. 1). DeCoste does not teach or suggest a backing with a first outer layer A, which is connected to a second layer C over the

entire area of outer layer A, the outer layer A being composed of a velour, scrim, woven fabric or formed-loop knit, and the layer C being composed of a textile having an open but stable three-dimensional structure as recited in amended claim 1.

Because the features of independent claim 1 are neither taught nor suggested by DeCoste, DeCoste cannot anticipate, and would not have rendered obvious, the features specifically defined in claim 1 and its dependent claims.

For at least these reasons, claims 1, 3, 5, 6 and 8 are patentably distinct from and/or non-obvious in view of DeCoste. Reconsideration and withdrawal of the rejections of the claims under 35 USC 102(b) are respectfully requested.

#### **IV. Rejection under 35 USC 103(b)**

Claims 2, 5 and 8 were rejected under 35 USC 103(a) as allegedly being unpatentable over DE 569 in view of DeCoste. This rejection is respectfully traversed.

The Patent Office acknowledges that DE 569 fails to teach or suggest a second outer layer B (see page 10 of the Office Action). The Patent Office introduces DeCoste as allegedly teaching a backing with a first outer layer A being composed of a scrim or woven fabric, and a second layer C being composed of a foam. The Patent Office alleges that the resulting combination of De 569 and DeCoste teaches or suggests each and every feature recited in claims 2, 5 and 8. Applicants respectfully disagree with the allegations regarding this rejection made by the Patent Office.

DeCoste does not remedy the deficiencies of DE 569 as described above with respect to independent claim 1, from which claims 2, 5 and 8 depend because DeCoste also fails to teach a first outer layer A (being composed of a velour, scrim,

woven fabric or formed-loop knit), and a layer C (being composed of a textile having an open but stable three-dimensional structure).

Thus, DE 569 and DeCoste, taken singly or in combination, fail to teach or suggest a tape having a backing with a first outer layer A, which is connected to a second layer C over the entire area of outer layer A, the outer layer A being composed of a velour, scrim, woven fabric or formed-loop knit, and the layer C being composed of a textile having an open but stable three-dimensional structure as required in amended claim 1.

Because these features of independent claim 1 are not taught or suggested by DE 569 and DeCoste, taken singly or in combination, these references would not have rendered the features of claim 1 obvious to one of ordinary skill in the art.

For at least these reasons, claims 2, 5 and 8 are patentable over DE 569 and DeCoste. Thus, withdrawal of the rejection under 35 USC 103(a) is respectfully requested.

## **V. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-12 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Early and favorable action is earnestly solicited.

**CONDITIONAL PETITION FOR EXTENSION OF TIME**

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

**ADDITIONAL FEE**

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

Respectfully submitted,  
NORRIS MCLAUGHLIN & MARCUS, P.A.

By       /Brian C. Anscomb/        
Brian C. Anscomb  
Reg. No. 48,641  
875 Third Avenue, 8<sup>th</sup> Floor  
New York, New York 10022  
Phone: (212) 808-0700  
Fax: (212) 808-0844